

REMARKS

Claims 1-31 are pending in this application, claims 7-24 and 27-31 having been withdrawn from consideration. By this Amendment, claims 2, 15 and 22 are amended. Support for the amendments to claims 2 and 15 can be found in the specification as originally filed, for example at page 4, lines 21-29, and in claim 2 as originally filed. Support for the amendment to claim 22 can be found in claims 21 and 22 as originally filed. Thus, no new matter is added by these amendments.

Also by this Amendment, the specification is amended. Specifically, the paragraph beginning on page 4, line 19 is amended to incorporate the subject matter of original claim 2 and the paragraph beginning on page 4, line 30 is amended to incorporate the subject matter set forth in original claim 5. Thus, no new matter is added by these amendments.

I. Notice of Non-Compliant Amendment

The February 24, 2005, Notice of Non-Compliant Amendment asserts that the September 29, 2005, Amendment does not comply with the requirements of 37 CFR §1.121 because claim 15 has an incorrect status identifier. Specifically, claim 15, which was previously withdrawn and which is amended, is identified as "Withdrawn - Currently Amended." Applicants respectfully submit that the September 29, 2005, Amendment is in compliance with the requirements of §1.121, and that the claim status identifier "Withdrawn - Currently Amended" is proper.

The Notice directed Applicants attention to a July 30, 2003, Patent Office flyer that indicates that withdrawn claims should be identified as "Withdrawn." *See* Office Flyer, <http://www.uspto.gov/web/offices/pac/dapp/opal/preognotice/officeflyer.pdf>). This flyer appears to indicate that the claim status identifier "Withdrawn" must be used regardless of whether a withdrawn claim is being amended.

However, the Consolidated Patent Rules indicate that the claim status identifier "Withdrawn - Currently Amended" is acceptable when a withdrawn claim is amended. Specifically, the current version of the Rules states that "[o]nly claims having the status of 'currently amended' or 'withdrawn' if also being amended, should include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as 'withdrawn - currently amended.'" *See* 37 C.F.R. §1.121(c)(2) (attached).

In light of the instructions of the most recent version available of the Rules, Applicants respectfully submit that claim 15 is correctly identified as "Withdrawn - Currently Amended" and that the September 29, 2004, Amendment should have been properly considered.

Applicants appreciate the courtesies shown to Applicants' representative by Examiner Gray during the March 14, 2005, telephone interview regarding this issue. In accordance with the Examiner's suggestion, Applicants respectfully submit herein the arguments contained in the September 29, 2004 Amendment.

II. Rejections Under 35 U.S.C. §112

The March 29, 2004, Office Action rejects claims 2 and 25 under 35 U.S.C. §112, first paragraph, as allegedly lacking enablement in the specification. The Office Action further rejects claim 2 under 35 U.S.C. §112, second paragraph, as allegedly lacking antecedent basis. Applicants respectfully traverse these rejections.

With respect to claim 25, the Office Action alleges that the specification does not provide support for the proportion by weight of the plasticizing medium of the composition to be between 120 and 145% by weight of resin. Applicants respectfully submit that this subject matter was set forth in the original application, specifically in claim 5 as originally filed. Applicants further submit that the specification has been amended to explicitly set forth the

subject matter recited in original claim 5. Thus, Applicants respectfully submit that claim 25 is enabled by the specification.

With respect to claim 2, the Office Action alleges that the specification does not support a halogen-free, fire-retarded plastic composition in which the weight proportion of the plasticizing medium comprising a phthalate is at most equal to 200% with respect to the weight of acrylic resin and that there is insufficient antecedent basis for the weight proportion of the plasticizing medium comprising a phthalate.

However, Applicants respectfully submit that this subject matter was set forth in the original application, specifically in claim 2 as originally filed. Applicants further submit that the specification has been amended to explicitly set forth the subject matter recited in original claim 2. Further, claim 2 has been amended to set forth that the weight proportion of the plasticizing medium comprising a phthalate or a phosphate is at most equal to 200% with respect to the weight of acrylic resin and/or the weight proportion of the intumescent agent is at most equal to 200% with respect to the weight of acrylic resin. Thus, both plasticizing medium comprising a phthalate and plasticizing medium comprising a phosphate were disclosed in the original application as having a maximum weight proportion of 200% relative to the weight of the resin. See Specification, page 4, lines 19-26; original claim 2. Applicants respectfully submit that claim 2 is supported by the specification and by the disclosures of the application as originally filed. Applicants further submit that the specification provides proper antecedent basis for all of the limitations of claim 2.

Accordingly, reconsideration and withdrawal of the rejections of claims 2 and 25 under 35 U.S.C. §112 is respectfully requested.

III. Rejections Under 35 U.S.C. §103(a)

A. Ferziger, Dias and Hudecek

The March 29, 2004, Office Action rejects claims 1-6, 25 and 26 under 35 U.S.C. §103(a) over U.S. Patent 4,801,493 to Ferziger et al. in view of U.S. Patent 4,256,786 to Dias et al and U.S. Patent 3,971,744 to Hudecek et al. Applicants respectfully traverse this rejection.

Independent claim 1 sets forth, in pertinent part, a "halogen-free fire-retarded plastic composition suitable for coating a substrate, comprising an acrylic resin and an intumescent agent, wherein: - said composition is in the plastisol state and comprises a plasticizing medium in which the acrylic resin and the intumescent agent are dispersed; - said composition exhibits, at low shear rates, Newtonian rheological behavior with a viscosity of less than 6000 mPa.s; and - said composition exhibits, at high shear rates, pseudoplastic rheological behavior." Claims 2-6, 25 and 26 depend, directly or indirectly, from claim 1.

Ferziger discloses chemically coated fabrics including a fiberglass fabric base to which at least one layer of a polymeric coating has been applied. *See* Ferziger, col. 3, lines 4-7. The fiberglass fabric base is "inherently flame retardant." *See* Ferziger, col. 3, lines 7-8. The Ferziger polymeric coating includes a polymeric carrier, which may be an acrylic resin and contains at least one flame retardant ingredients, and may also contain a plasticizer, such as an organic phosphate, and fillers. *See* Ferziger, col. 4, lines 1-37.

However, as admitted by the Office Action, Ferziger does not disclose or suggest the inclusion of an intumescent agent, as set forth in claim 1. The Office Action also admits that Ferziger does not disclose or suggest the use of a phthalate as a plasticizer.

Applicants respectfully submit that Ferziger also does not disclose or suggest that its coating composition has Newtonian rheological properties at low shear rates and pseudoplastic rheological properties at high shear rates, as set forth in claim 1.

Thus, Ferziger alone would not have rendered claims 1-6, 25 and 26 obvious. Dias does not remedy the shortcomings of Ferziger.

Dias discloses a composition to impart chemical and fire resistance to polyurethane foams and textiles. *See* Dias, col. 1, lines 11-16. The Dias compositions are aqueous slurries of active carbon, chemical fire retardants and resin binders, such as acrylic resins. *See* Dias, col. 1, lines 57-61. Dias discloses that its coating composition is applied by immersion in an aqueous dispersion. *See* Dias, col. 4, lines 33-36.

Applicants respectfully submit that Dias, like Ferziger, does not disclose or suggest the inclusion of an intumescent agent, as set forth in claim 1. In addition, Dias does not disclose or suggest that its coating composition is in a plastisol state or has Newtonian rheological properties at low shear rates and pseudoplastic rheological properties at high shear rates, as set forth in claim 1.

Thus, Ferziger and Dias, alone or in combination, would not have rendered claims 1-6, 25 and 26 obvious. Hudecek does not remedy the shortcomings of Ferziger and Dias.

Hudecek discloses a method for forming emulsions, concentrated dispersions and pastes based on plasticizers and hydrophilic fillers. *See* Hudecek, col. 1, lines 5-7.

However, Applicants respectfully submit that Hudecek, like Ferziger and Dias, does not disclose or suggest the inclusion of an intumescent agent, as set forth in claim 1. In addition, Hudecek does not disclose or suggest that its coating composition is in a plastisol state or has Newtonian rheological properties at low shear rates and pseudoplastic rheological properties at high shear rates, as set forth in claim 1.

Accordingly, Applicants respectfully submit that claims 1-6, 25 and 26 are patentable over Ferziger, Dias and Hudecek, individually and in combination. Reconsideration and withdrawal of the rejection are respectfully requested.

B. Bridge and Hudecek

The March 29, 2004, Office Action rejects claims 1-6, 25 and 26 under 35 U.S.C. §103(a) over British Patent Application Publication 2,079,801 to Bridge et al. in view of Hudecek. Applicants respectfully traverse this rejection.

Claim 1 is as set forth above.

Bridge teaches glass fabrics treated with a non-intumescent, char forming composition. *See* Bridge, Abstract. The Office Action admits that Bridge does not disclose or suggest the use of a phthalate as a plasticizer.

Bridge does not, as is evident from its Abstract, disclose or suggest the inclusion of an intumescent agent, as set forth in claim 1. *See* Bridge, Abstract. In addition, Bridge does not disclose or suggest that its coating composition is in a plastisol state or has Newtonian rheological properties at low shear rates and pseudoplastic rheological properties at high shear rates, as set forth in claim 1.

Thus, Bridge alone would not have rendered claims 1-6, 25 and 26 obvious. Hudecek does not remedy the shortcomings of Bridge.

As discussed above, Hudecek does not disclose or suggest the inclusion of an intumescent agent, as set forth in claim 1. In addition, Hudecek does not disclose or suggest that its coating composition is in a plastisol state or has Newtonian rheological properties at low shear rates and pseudoplastic rheological properties at high shear rates, as set forth in claim 1.

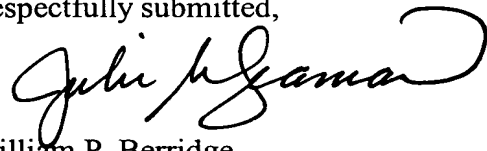
Accordingly, Applicants respectfully submit that claims 1-6, 25 and 26 are patentable over Bridge and Hudecek, individually and in combination. Reconsideration and withdrawal of the rejection are respectfully requested.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-31 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachment:

37 C.F.R. §1.121(c)(2)

Date: March 24, 2005

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DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461
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(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

(c) The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or reexamination proceeding from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination prosecution from termination under § 1.550(d) or § 1.957(b) or limitation of further prosecution under § 1.957(c).

(d)(1) Notwithstanding the provisions of paragraph (b) of this section, no amendment other than canceling claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(2) Notwithstanding the provisions of paragraph (b) of this section, an amendment made after a final rejection or other final action (§ 1.113) in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 may not cancel claims where such cancellation affects the scope of any other pending claim in the reexamination proceeding except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

(f) Notwithstanding the provisions of paragraph (e) of this section, no affidavit or other evidence can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(g) After decision on appeal, amendments, affidavits and other evidence can only be made as provided in §§ 1.198 and 1.981, or to carry into effect a recommendation under § 41.50(c) of this title.

[24 FR 10332, Dec. 22, 1959; 46 FR 29183, May 29, 1981; para. (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); paras. (b) and (d) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 1.117 [Reserved]

[Removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.118 [Reserved]

[48 FR 2712, Jan. 20, 1983, effective Feb. 27, 1983; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.119 [Reserved]

[32 FR 13583, Sept. 28, 1967; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.121 Manner of making amendments in applications.

(a) *Amendments in applications, other than reissue applications.* Amendments in applications, other than reissue applications, are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.

(b) *Specification.* Amendments to the specification, other than the claims, computer listings (§ 1.96) and sequence listings (§ 1.825), must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification, in the manner specified in this section.

(1) *Amendment to delete, replace, or add a paragraph.* Amendments to the specification, including amendment to a section heading or the title of the invention which are considered for amendment purposes to be an amendment of a paragraph, must be made by submitting:

(i) An instruction, which unambiguously identifies the location, to delete one or more para-

graphs of the specification, replace a paragraph with one or more replacement paragraphs, or add one or more paragraphs;

(ii) The full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strikethrough cannot be easily perceived;

(iii) The full text of any added paragraphs without any underlining; and

(iv) The text of a paragraph to be deleted must not be presented with strike-through or placed within double brackets. The instruction to delete may identify a paragraph by its paragraph number or include a few words from the beginning, and end, of the paragraph, if needed for paragraph identification purposes.

(2) *Amendment by replacement section.* If the sections of the specification contain section headings as provided in § 1.77(b), § 1.154(b), or § 1.163(c), amendments to the specification, other than the claims, may be made by submitting:

(i) A reference to the section heading along with an instruction, which unambiguously identifies the location, to delete that section of the specification and to replace such deleted section with a replacement section; and;

(ii) A replacement section with markings to show all changes relative to the previous version of the section. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived.

(3) *Amendment by substitute specification.* The specification, other than the claims, may also be amended by submitting:

(i) An instruction to replace the specification; and

(ii) A substitute specification in compliance with §§ 1.125(b) and (c).

(4) *Reinstatement of previously deleted paragraph or section.* A previously deleted paragraph or section may be reinstated only by a subsequent amendment adding the previously deleted paragraph or section.

(5) *Presentation in subsequent amendment document.* Once a paragraph or section is amended in a first amendment document, the paragraph or section shall not be represented in a subsequent amendment document unless it is amended again or a substitute specification is provided.

(c) *Claims.* Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing.* All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of “canceled” or “not entered” may be aggregated into one statement (e.g., Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of “currently amended,” and be submitted with markings to indicate the changes that have been made relative to the immediate prior

version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of “currently amended,” or “withdrawn” if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as “withdrawn—currently amended.”

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, *i.e.*, without any markings in the presentation of text. The presentation of a clean version of any claim having the status of “original,” “withdrawn” or “previously presented” will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of “withdrawn” or “previously presented.” Any claim added by amendment must be indicated with the status of “new” and presented in clean version, *i.e.*, without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of “canceled” or “not entered.”

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as “canceled” will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a “new” claim with a new claim number.

(d) *Drawings:* One or more application drawings shall be amended in the following manner: Any changes to an application drawing must be in compliance with § 1.84 and must be submitted on a replacement sheet of drawings which shall be an attachment to the amendment document and, in the top margin,

labeled “Replacement Sheet”. Any replacement sheet of drawings shall include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. Any new sheet of drawings containing an additional figure must be labeled in the top margin as “New Sheet”. All changes to the drawings shall be explained, in detail, in either the drawing amendment or remarks section of the amendment paper.

(1) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as “Annotated Sheet” and must be presented in the amendment or remarks section that explains the change to the drawings.

(2) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

(e) *Disclosure consistency.* The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(f) *No new matter.* No amendment may introduce new matter into the disclosure of an application.

(g) *Exception for examiner’s amendments.* Changes to the specification, including the claims, of an application made by the Office in an examiner’s amendment may be made by specific instructions to insert or delete subject matter set forth in the examiner’s amendment by identifying the precise point in the specification or the claim(s) where the insertion or deletion is to be made. Compliance with paragraphs (b)(1), (b)(2), or (c) of this section is not required.

(h) *Amendment sections.* Each section of an amendment document (*e.g.*, amendment to the claims, amendment to the specification, replacement drawings, and remarks) must begin on a separate sheet.

(i) *Amendments in reissue applications.* Any amendment to the description and claims in reissue applications must be made in accordance with § 1.173.

(j) *Amendments in reexamination proceedings.* Any proposed amendment to the description and claims in patents involved in reexamination proceedings must be made in accordance with § 1.530.

(k) Amendments in provisional applications.

Amendments in provisional applications are not usually made. If an amendment is made to a provisional application, however, it must comply with the provisions of this section. Any amendments to a provisional application shall be placed in the provisional application file but may not be entered.

[32 FR 13583, Sept. 28, 1967; 46 FR 29183, May 29, 1981; para. (e), 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (i) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 68 FR 38611, June 30, 2003, effective July 30, 2003; para. (d) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

§ 1.122 [Reserved]

[24 FR 10332, Dec. 22, 1959; para. (b), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.123 [Reserved]

[48 FR 2712, Jan. 20, 1983, effective Feb. 27, 1983; 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; amended, 58 FR 38719, July 20, 1993, effective Oct. 1, 1993; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.124 [Reserved]

[Removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.125 Substitute specification.

(a) If the number or nature of the amendments or the legibility of the application papers renders it difficult to consider the application, or to arrange the papers for printing or copying, the Office may require the entire specification, including the claims, or any part thereof, be rewritten.

(b) Subject to § 1.312, a substitute specification, excluding the claims, may be filed at any point up to payment of the issue fee if it is accompanied by a statement that the substitute specification includes no new matter.

(c) A substitute specification submitted under this section must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown pursuant to this paragraph.

(d) A substitute specification under this section is not permitted in a reissue application or in a reexamination proceeding.

[48 FR 2712, Jan. 20, 1983, effective Feb. 27, 1983; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (b)(2) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (b) and (c) revised, 68 FR 38611, June 30, 2003, effective July 30, 2003]

§ 1.126 Numbering of claims.

The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled the remaining claims must not be renumbered. When claims are added, they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant.

[32 FR 13583, Sept. 28, 1967; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]